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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,366	08/22/2001	J. Fernando Bazan	15631-0004801US	1749
28008	7590	03/25/2004	EXAMINER	
DNAX RESEARCH, INC. LEGAL DEPARTMENT 901 CALIFORNIA AVENUE PALO ALTO, CA 94304			MERTZ, PREMA MARIA	
			ART UNIT	PAPER NUMBER
			1646	

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/935,366	<b>Applicant(s)</b> BAZAN, J. FERNANDO	
	<b>Examiner</b> Prema M Mertz	<b>Art Unit</b> 1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                        |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

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### **DETAILED ACTION**

1. Claims 1-17 have been canceled on 12/2/2003. New claims 18-24 (12/2/2003) are under consideration.
2. Receipt of applicant's arguments and amendments filed 12/2/2003 is acknowledged.
3. The following previous rejections are withdrawn in light of applicants amendments filed on 12/2/2003:
  - (i) the rejection of claims 1, 3-7, 9-10, 12-17 under 35 U.S.C. 112, first paragraph, for lack of enablement;
  - (ii) the rejection of claims 1, 3-7, 9-10, 12-17 under 35 U.S.C. 112, first paragraph, for lack of written description;
  - (iii) the rejection of claims 3-4 are rejected under 35 U.S.C. 112, first paragraph, for new matter; and
  - (iv) the rejection of claims 3-4, 14, 16-17 under 35 U.S.C. 112, second paragraph. However, Applicant's arguments with respect to the 35 U.S.C. 112, second paragraph are rendered moot in light of a new ground of rejection over new claims 22-23.
4. Applicant's arguments filed on 12/2/2003 have been fully considered but were persuasive in part. The issues remaining and new issues, are stated below.
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Pursuant to 37 CFR 1.178, Applicants have submitted the original letters patent as Exhibit B. The submission of the original patent is acknowledged.

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***Formal matters***

7. The amendment filed on 12/2/2003 proposes amendments to claims 18-24 that do not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in reissue applications. A supplemental paper correctly amending the reissue application is required.

Amendments to the claims may only be made as set forth in 37 CFR 1.173(b)(2), as follows:

Any change to the text of a claim (original or new) must be presented as an entire numbered claim. All subject matter being added to an original patent claim must be underlined. All subject matter being deleted from an original patent claim must be placed between brackets. 37 CFR 1.173(b)(2) and (d). Subject matter being added to a new claim requires **rewriting** and **underlining** of the entire new claim.

In the instant application, the amendments submitted on 12/2/2003 are non-compliant because the subject matter being added to the new claims has not been underlined. It is requested that in response to this action, pursuant to 37 CFR 1.173(b)(2) and (d), Applicants submit a compliant amendment with proper underlining of the new claims.

6. Claims 18-24 are rejected as being based upon a defective declaration under 35 U.S.C. 251. See 37 CFR 1.175.

This rejection is being maintained for the reasons set forth in the last office action dated 7/2/2003.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37

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CFR 1.175(b)(1) must be received before this reissue application can be allowed. Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251.

Applicants have submitted a supplemental oath/declaration on 12/2/2003. However, the declaration submitted on 12/2/2003 recites that Applicants have reviewed the amendments filed on 3/20/2002 and 1/30/2003 and stating that every such error arose without any deceptive intention on the part of the Applicant. However, the latest amendment submitted on 12/2/2003 was filed after 1/30/2003. It is not clear from the declaration of 12/2/2003 that Applicants have reviewed the latest amendment of 12/2/2003 and could also state that it arose without deceptive intent. It is suggested that in the supplemental oath/declaration, Applicants state that all submitted amendments have been reviewed by Applicants.

***Claim rejections- 35 USC 112, second paragraph***

7. Claims 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22, is vague and indefinite because it recites “variant”. It is unclear whether the “variant” is of the polynucleotide or a “variant” of something else.

Claim 23 is rejected as improperly dependent on claim 18. For example, claim 23 recites “...the mature polypeptide of SEQ ID NO:2, 4 or 5”, which limitation is broader than the limitations of independent claim 18.

***Conclusion***

No claim is allowed.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (571) 272-0876. The examiner can normally be reached on Monday-Friday from 7:00AM to 3:30PM (Eastern time).

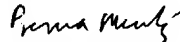
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (571) 271-0871.

Official papers filed by fax should be directed to (703) 872-9306. Faxed draft or informal communications with the examiner should be directed to (571) 273-0876.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
Prema Mertz Ph.D.  
Primary Examiner

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March 15, 2004